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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,063	08/15/2000	Takao Terasa	195821US2	1517
22850	7590	02/08/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	
DATE MAILED: 02/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/638,063	Applicant(s) TERASE, TAKAO	
	Examiner Andrew J. Fischer	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10,12-15,18-33,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10,12-15,18-33,35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- ajf a) ☒ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on November 15, 2005. This application was under a final rejection (the “Second Final Office Action” mailed February 15, 2005) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the Second Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114.

Acknowledgements

2. In accordance with the RCE noted above, Applicant’s amendment filed November 15, 2004 has been entered. Accordingly, claims 3-10, 12-15, 18-33, 35, and 36 remain pending.

3. This Office Action, the “First Non Final Office Action” is given Paper No. 20060204.

4. Applicant’s perfection of foreign priority is acknowledged.

5. All references in this Office Action to the capitalized versions of “Applicant” refers specifically the Applicant of record. References to lower case versions of “applicant” or “applicants” refers to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” in this Office Action refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally.

6. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Claim Rejections - 35 USC §112 2nd Paragraph

7. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 15 is rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 15, it is unclear if the “portable table top terminal” is the same or different form the “portable table top terminal” of claim 3.

Claim Rejections - 35 USC §102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 3-10, 12-15, 18-33, 35, and 36, as understood by the Examiner are rejected under 35 U.S.C. §102(e) as being anticipated by Olewicz et. al. (U.S. 6,973,437 B1)(“Olewicz”).

Olewicz discloses a tabletop terminal 12, a kitchen terminal 55; a head office terminal (office or manager’s terminal); a control unit (the central server); a worktable terminal (the hostess unit

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53); a waiter unit 14 which has waiter ID, [C8, L60+]; an accounting unit (the software which processes the customer's bill as in step 141); data is transmitted via radio communications ("RF"); the hostess units and Internet websites are configured to indicate at wait times and at least vacant tables; a housing 21 with mounting plate 32 which includes a plate 33 and a base unit 34 which are attached permanently to the table or booth and wherein the base unit 34 serves as a docking station for communications device 26, C6, L51-67.

Claim Rejections - 35 USC §103

11. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3-10, 12-15, 18-33, 35, and 36, as understood by the Examiner are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Olewicz in view of Smith et. al. (U.S. 5,826,043)("Smith").¹ It is the Examiner's principle position that the claims are anticipated because the base unit 34 in Olewicz is the terminal receptacle since its provided at the customer location and is configured to receive the portable tabletop terminals thereon.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Olewicz as taught by Smith to include Smith's idea of identifying the docking station with the computer. Such a modification would have allowed the identification of table stations which might ultimately provide for the

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identification of patrons as discussed in Kurland (U.S. 4,547,851). Moreover, Smith would have allowed different devices to be used at different customer locations so that if one of the computer devices was broken, it could be more easily replaced.

13. Claim 18, as understood by the Examiner, is alternatively rejected under 35 U.S.C.

§103(a) as being unpatentable over the Olewicz/Smith combination in further view of Todd

(U.S. 6,072,393 B1). The Olewicz/Smith combination discloses as discussed above but does not directly disclose an alarm if not placed on a receptacle. Todd teaches using an alarm to alert appropriate persons if the computer is not placed on a recognized receptacle.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Olewicz/Smith combination as taught by Todd to include Todd's alarm system. Such a modification would have helped deter theft and catch thieves in the act of absconding with a table top terminal.

14. Claim 19, as understood by the Examiner, is alternatively rejected under 35 U.S.C.

§103(a) as being unpatentable over the Olewicz/Smith combination in further view of Duphorne

(U.S. 6,212,265 B1). The Olewicz/Smith combination discloses as discussed above but does not directly disclose an email system. Duphorne teaches using an email system to receive food orders sent by a customer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Olewicz/Smith combination as taught by Duphorne to include sending email between terminals. Such a modification would have allowed the

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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customers in the Olewicz/Smith to communicate with other customers while awaiting their order. Such is the idea behind many Internet cafes.

15. For due process purposes, the Examiner again confirms that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,² the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements³ with the required clarity, deliberateness, and precision.⁴ Third, after receiving express notice in the previous office actions of the Examiner's position that lexicography is not invoked,⁵ Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in

² See the First Non Final Office Action mailed September 30, 2003, Paragraph No. 9; the First Final Office Action mailed January 14, 2004, Paragraph No. 18; the Second Non Final Office Action mailed August 26, 2004, Paragraph No. 10; and the Second Final Office Action mailed February 15, 2005, assigned Paper No. 02112005, Paragraph No. 11 beginning on page 7.

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁵ See Note 2.

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accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography is invoked).

Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has again declined the Examiner's express invitation⁶ to be his own lexicographer.⁷ Accordingly and for due process purposes, the Examiner maintains his position that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁸ The Examiner continues to rely heavily and extensively on this interpretation.⁹ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

⁶ Id.

⁷ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed February 4, 2006).

⁸ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

⁹ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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16. Under the broadest reasonable interpretation standard noted above and unless modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous office actions. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary¹⁰) during ex parte examination.

17. The Examiner maintains his position regarding product claims as noted in Paragraph No. 12 in the Second Final Office Action.

18. The Examiner maintains his position regarding product claims and functional language as noted in Paragraph No. 13 in the Second Final Office Action.

Response to Arguments

19. Applicant's arguments filed November 15, 2005 with the RCE have been fully considered.

20. Applicant's arguments with respect to the claims and the prior art have been considered but are moot in view of the new grounds of rejection.

¹⁰ See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (“[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.”).

Previously Indicated Findings of Fact & Conclusions of Law

21. First, Applicant is reminded that unless expressly withdrawn, reversed, or noted elsewhere in this paragraph, all findings of fact and conclusions of law—as indicated in all previous office action(s) within the prosecution history¹¹ of this patent application—are maintained in this office action and will continue to be maintained by the Examiner and the USPTO in any future office actions and/or correspondence.¹² During the course of examination, it is axiomatic that the some of the previously indicated findings of fact and/or conclusions of law may become moot. However, to the extent that they remain applicable to the examination process, the Examiner continues to rely on these previously indicated findings of fact and conclusions of law. Second, because patent applicants quite often either do not read the office action or simply fail to comprehend and appreciate the implications of an examiner's findings of fact and/or conclusions of law, any subsequent reiterations, clarifications, and/or discussions of a previously indicated finding of fact and/or conclusion of law in an office action are provided strictly for due process purposes. Thus, unless an examiner provides an express statement either

¹¹ The prosecution history of this application includes all papers of record and, if applicable, all papers of record in a related application. "The prosecution history contains the complete record of all the proceedings before the Patent and Trademark Office . . ." *Dow Chemical Co. v. Sumitomo Chemical America, Inc.*, 257 F.3d 1372, 1373, 59 USPQ2d 1609, 1614 (Fed. Cir. 2001) (citations omitted). "When a patent is granted, prosecution is concluded, the intrinsic record is fixed, and the public is placed on notice of its allowed claims." *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002). See also *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350, 69 USPQ2d 1815, 1823 (Fed. Cir. 2004) (holding that statements made in prosecution of one patent are relevant to the scope of all sibling patents).

¹² 'Correspondence' includes but is not limited to documents from the USPTO such as office actions, advisory actions, restriction requirements, requests for information, examiner's answers, notice of non-responsive amendments, ex parte Quayle letters, petition decisions, Board of Patent Appeals and Interferences decisions, commissioner's orders, and other documents.

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withdrawing or contradicting the previously indicated finding of fact or conclusion of law, these subsequent reiterations, clarifications, and/or discussions are just that—reiterations, clarifications, and/or discussions and are in no way a waiver (either express or implied) by the examiner of his or her position on the matter. Likewise, an examiner's subsequent *omission or failure* to reiterate, clarify, and/or discuss a previously indicated finding of fact or conclusion of law in a subsequent office action is also in no way a waiver (either express or implied) of the examiner's position on the matter. This subsequent omission or failure to reiterate, clarify, and/or discuss a previously indicated finding of fact or conclusion of law in a subsequent office action is intended to shorten the subsequent office action as much as practically possible yet still allowing the examiner to rely on those previously indicated findings of fact or conclusions of law. Third, Applicant is reminded that in order to receive a 'Notice of Allowability' (*i.e.* Form PTO-37), applicants must overcome all outstanding 'objections' and 'rejections'¹³ made by an examiner. Therefore in light of the above and notwithstanding the other sentences in this paragraph, all objection(s) and/or rejection(s) from any previous office action that are not maintained in this Office Action are either overcome by Applicant and/or are hereby withdrawn by the Examiner.

¹³ Applicants can recognize an 'objection' by the an examiner's express use of the phrase "objected to" in an office action. Likewise, applicants can recognize a 'rejection' by the an examiner's express use of the term "rejected" in an office action. Therefore any finding of fact or conclusion of law made by an examiner that does *not* expressly use either the phrase "objected to" or the term "rejected" are *not* considered objections or rejections and are therefore not a "*requirement*" for obtaining a patent as described in MPEP §707.07(e). See also MPEP §706.01 for a discussion of the differences between "objections" and "rejections."

Regarding Indefiniteness Under 35 USC §112 2nd Paragraph¹⁴

22. First, the Examiner notes that the primary purpose of the definiteness requirement is to provide notice. “The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. That determination requires a construction of the claims according to the familiar canons of claim construction.” *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774, 779-80, 64 USPQ2d 1945, 1949 (Fed. Cir. 2002) (citations omitted).

23. Second, it is the Examiner’s position that during ex parte examination, if a claim in a utility patent application is indefinite on its face, the claim is indefinite. “If the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie.” *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 423 (CCPA 1973) (citations and quotations omitted). Moreover, this definiteness determination is made as of the effective filing date. See *e.g. Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986) (analyzing definiteness as of the filing date).

24. Third, if a claim is indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to completely and accurately construe claim scope. See *Honeywell International Inc. v. ITC*, 68

¹⁴ Because this application has now been at least twice rejected and is therefore eligible for appeal to the USPTO’s Board of Patent Appeals and Interferences (“Board”), because of recent decisions by the Board and the Board’s position on indefiniteness, and in order to help and enable Applicant to craft reasoned arguments should Applicant eventually decide to appeal an indefiniteness rejection to the Board, the Examiner has provided the following discussion on indefiniteness under 35 USC §112 2nd paragraph. Therefore Applicant should consider the following as actual notice of the Examiner’s position regarding indefiniteness.

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USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims in this application are construed and the art is applied *as much as practically possible*.

25. Forth, the Examiner recognizes that breath of a claim is not be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). However, “[i]f the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate.” MPEP §2173.02 citing *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). In other words, claim breath indicates the range or scope a claim limitation covers while the metes and bounds indicate where the claimed subject matter begins and ends. These are two principles are distinct and separate principles. A broad claim—like a narrow claim—may or may not have clear metes and bounds and thus may or may not be definite. Thus, if a person of ordinary skill in the art could not interpret the metes and bounds of a claim—even a broad claim—so as to understand how to avoid infringement, the claim is indefinite.

26. Fifth, a claim in a utility patent application is either indefinite under 35 U.S.C. §112, 2nd paragraph or it is not. Contrary to recent decisions of the USPTO’s Board of Patent Appeals and Interferences (“Board”), the law does not recognize a ‘scale’ or ‘range’ of indefiniteness such as ‘slightly indefinite,’ ‘somewhat indefinite,’ or ‘not too indefinite.’ There is no middle ground since at the end of the day, ‘slightly indefinite,’ ‘somewhat indefinite,’ or ‘not too indefinite’ are nevertheless still indefinite. The Examiner frequently receives arguments from applicants and

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decisions from the Board where the parties respectively argue that ‘the examiner knows what is meant by the term’ or ‘the language is clear from the specification.’ However these arguments can not overcome claim language that is indefinite on its face. In other words, “semantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]” *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).¹⁵ Again, so as to be especially clear, a claim is either indefinite—or it is not indefinite. When the claim is indefinite, the claim by definition, can not be construed. And if the indefiniteness is rendered during ex parte examination, neither the specification nor the prosecution history can be used to rectify the indefiniteness.¹⁶

27. Sixth, the Examiner recognizes that “compliance with Section 112 Para. 2 is a question of law.” *In re Dossel*, 115 F.3d 942, 944, 42 USPQ2d 1881, 1883 (Fed. Cir. 1997). Additionally, when questions of indefiniteness arise, we use general principles of claim construction. “In the face of an allegation of indefiniteness, general principles of claim construction apply.” *Datamize LLC v. Plumtree Software Inc.*, 417 F.3d 1342, 75 USPQ2d 1801, 1805 (Fed Cir. 2005) citing *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1340-41, 65 USPQ2d 1321, 1326 (Fed. Cir.

¹⁵ As a practical matter, a patent applicant almost always has an opportunity to correct indefiniteness by filing either an amendment to a non final office action, or alternatively if in response to a final office action, filing a request for continued examination (“RCE”) under 37 C.F.R. §1.114 along with an amendment.

¹⁶ Compare *Exxon Research and Engineering Co. v. U.S.*, 265 F.3d 1371, 60 USPQ2d 1272 (Fed. Cir. 2001) vs. *In re Jolly*, 172 F.2d 566, 80 USPQ 504 (CCPA 1949). In *Exxon Research*, the Court of Appeals for the Federal Circuit reviewed “similar claim language” as was interpreted in *Jolly* (where the language in question was held to be indefinite) and held that for purposes of indefiniteness, claims are interpreted differently during ex parte examination than the same claim phases during inter parte litigation.

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2003) (noting that a determination of definiteness “requires a construction of the claims according to the familiar canons of claim construction”). However, a patent claim that is indefinite on its face can not be rendered ‘definite’ by a reviewing body simply because the result would otherwise be inequitable or unfair to applicant, because the result would otherwise be too harsh or severe since it might result in the patent application becoming abandoned, or because rendering the claim indefinite is against some noble policy. “Claim construction, however, is not a policy-driven inquiry. As stated earlier, it is a contextual interpretation of language. The scope of patent claims can neither be broadened nor narrowed based on abstract policy considerations regarding the effect of a particular claim meaning.” *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 70 USPQ2d 1737, 1742-43 (Fed. Cir. 2004) (quoting *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1584, 36 USPQ2d 1162, 1168 (Fed. Cir. 1995) (“[I]t is well settled that no matter how great the temptations of fairness or policy making, courts do not redraft claims”), *vacated on other grounds by* 403 F.3d 1328, 74 USPQ2d 1396 (Fed. Cir. 2005)(en banc).

28. Seventh, should Applicant end up appealing this application and should the Board have any questions regarding indefiniteness under 35 U.S.C. §112, 2nd paragraph and its application during ex parte examination when compared with inter parte litigation, the Examiner respectfully requests the Board to remand this application to the Examiner in order to provide additional guidance.

29. The Examiner concludes this section by reiterating that during ex parte examination, when a patent claim is rejected for indefiniteness because the claim is indefinite on its face, the claim can not be construed. In such a case, the application of prior art by an examiner or the Board is immaterial. Yet in order to avoid piecemeal examination, MPEP §2173.06 states that

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even if the examiner takes a position that a claim is indefinite, it is USPTO policy to nevertheless make an attempt at application of the prior art. However, neither this policy decision as set forth in MPEP §2173.06 nor even *any* policy decision by the USPTO can change the substantive standard for indefiniteness and thus the standard for a 35 U.S.C. §112 2nd paragraph rejection.¹⁷ So no matter how slight the indefiniteness may be, no matter how equitable applicant's arguments may seem, and no matter how great the temptations of fairness or policy making may appear to the Board, during ex parte examination, if a claim is indefinite on its face, the claim is just that—indefinite.

Conclusion

30. References considered pertinent to Applicant's disclosure are listed on form PTO-892.

All references listed on form PTO-892 are cited in their entirety.

31. Unless expressly noted otherwise by the Examiner or other USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action *and* any future office action(s), communication(s), or other correspondence provided by the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8th Edition, Rev. 4, October 2005; citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8th Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100,

¹⁷ See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1559, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) ("As we [the Federal Circuit] have previously held, the broadest of the PTO's rulemaking powers—35 U.S.C. Section 6(a)—authorizes the Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the [PTO]'; it does not grant the Commissioner the authority to issue substantive rules.").

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1500, 2000, 2500, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8th Edition, August 2001.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

33. Applicant is reminded that patents are written by and for skilled artisans. See *e.g. Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicant is a skilled artisan who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in the reference(s), Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the

Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant's response must also state *why* he either does not understand or *why* he has difficulty comprehending the offending reference(s). If after properly receiving (*i.e.* Applicant's response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicant is given actual notice that this paragraph becomes effective when Applicant receives notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicant submits an Information Disclosure Statement or when Applicant receives an examiner's Notice of References Cited (Form PTO-892)).

34. Additionally, Applicant is reminded that it is inappropriate for the USPTO to disregard any relevant evidence of record. "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) ("All the evidence on the question of obviousness must be considered."); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]"); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002)("Patentability vel non is then determined on the *entirety* of the record, by a preponderance

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of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]”); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as “Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]”). Third, any factual determination by the USPTO that does not consider *all* relevant evidence may not be supported by substantial evidence¹⁸ since the particular evidence *not* considered may be probative of a factual issue presented. Forth, it is well established that “[a] reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701.¹⁹ Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, because any evidence *not* considered by the USPTO may be probative of at least one factual issue presented, and because anticipation is determined by the teachings of a reference in combination with the

¹⁸ Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938).

¹⁹ See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same statement of law and also citing *In re LeGrice*.

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knowledge of one of ordinary skill in the art, Applicant is hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art.

35. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has yet again provided Applicants with actual notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (beginning on page 9) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,²⁰ the Examiner again respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. As noted previously by the Examiner, by addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. Again, if Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander

²⁰ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.

 2/4/06

Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
February 4, 2006